Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE M. ALLEMAN JR., ROLAND ZEDER, and ALEX BALLY

Appeal No. 2003-1650
Application No. 09/411,106

ON BRIEF

Before GARRIS, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is hereby remanded to the Examiner via the Office of the Director for Technology Center 1700 for appropriate action consistent with our comments below.

On page 2 of the answer, the Examiner states that "[t]he rejection of claims 2, 7, 11, 56, and 75 has been withdrawn." Although the Examiner has not specified the statutory basis of the aforementioned "rejection," it appears that only the § 103 rejection of the previously listed claims has been withdrawn.

That is, the § 112, first paragraph, rejection listed on pages 4 and 5 of the answer is maintained against claims 56 and 75[1].

Notwithstanding the Examiner's above noted attempt to clarify the application file record with respect to the status of pending versus withdrawn rejections, a study of this record including a comparison of the answer and the final Office action reveals that the status of several final rejections and pending claims is unclear. Specifically, the status of the final rejection of claims 71-73 and 82 under the first paragraph of § 112 (see page 3 of the final Office action) is unclear because this rejection has neither been repeated in the answer nor withdrawn by the Examiner. For the same reason, the final rejection of claims 29, 30 and 31 under the second paragraph of § 112 (see page 3 of the final Office action) also is unclear. Likewise, the record is unclear with respect to the status of the § 103 rejection based on Karpoff, Sueshige and Magda (see page 5 of the final Office action) as regards claims 4, 6, 8, 10, 12, 14, 15, 17, 18, 23, 25, 27, 28, 30 and 31. Analogously, the record is unclear with respect to the status of the final rejection under § 103 based on Karpoff, Sueshige, Magda

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[1] The claims listed in this § 112, first paragraph, rejection inappropriately include canceled claim 51. The Examiner should rectify this inappropriate inclusion in any further actions which involve this rejection.

and Momberg (see page 8 of the final Office action) as regards claims 20 and 21. Similarly, the record requires clarification with respect to the final rejection under § 103 based on Karpoff and Magda (see page 9 of the final Office action) as regards claim 56.

The Examiner's failure to clarify the record concerning the status of these rejections and claims is particularly unfortunate because at least some of these rejections and claims have been separately and specifically argued by the Appellants (e.g., see pages 14, 15, 27-30, 32, and 38 of the brief wherein arguments are advanced against each of these rejections and the arguments involve at least some of the claims under consideration), whereas the Examiner in her answer fails to acknowledge much less address any of these arguments. More unfortunate is the fact that the Examiner or more precisely (and even more unfortunately) the Supervisory Patent Examiner has entered the Appellants' reply brief without responding to the comments therein (e.g., see the first and second full paragraphs on page 6, the second full paragraph on page 9, the first full paragraph on page 11 and the paragraph bridging pages 11 and 12 of the reply brief) regarding the Examiner's failure to mention these rejections and claims. Presumably, these multiple and repeated omissions by the Examiner and her Supervisory Patent

Examiner were occasioned by inadvertent oversight. Regardless of their origin, these omissions have obfuscated to an unacceptable extent the status of the aforenoted rejections and claims on the record of this appeal.

In light of the foregoing, the Examiner must respond to this remand by clarifying the application file record with respect to the status of each of the rejections and claims discussed above.

As previously indicated, the Examiner in her answer has failed to respond to many of the arguments advanced by the Appellants in their brief. In response to this remand, the Examiner must rebut each and every argument presented in the brief with respect to each and every rejection of each and every claim which ultimately is maintained by the Examiner. We here note that the Examiner seems confused regarding the issue of claim grouping and argument vis-à-vis the separate consideration of an individual claim. For purposes of clarification, we point out that an Examiner is required to give separate consideration to an individual claim when an Appellant (1) merely states that the claims are grouped separately and (2) presents a separate, specific argument regarding the individual claim. See 37 CFR § 1.192(c)(7)(8)(2003) as well as Ex parte Schier, 21 USPQ2d 1016, 1018 (Bd. Pat. App. & Int. 1991)

and the Manual of Patent Examining Procedure (MPEP) § 1206 (August 2001).

We observe that neither the final Office action nor the answer includes a § 103 rejection of dependent claims 71-73, 75 and 82. It is not apparent from the file record whether the Examiner has failed to so reject these claims by deliberate intention or by inadvertent oversight. If this failure is by oversight, the Examiner should correct it. On the other hand, if the Examiner deliberately intended for these claims to not be rejected over prior art, the Examiner should provide the application file record with a statement to that effect and an explanation as to why these particular claims are considered to patentably distinguish over the prior art.

To the extent that no new ground of rejection is involved (see MPEP § 1208.01), the Examiner's response to this remand may be in the form of a supplemental Examiner's answer (see 37 CFR § 1.193(b)(1) and MPEP § 1211). Any such supplemental answer, in addition to rectifying the previously discussed infirmities, must contain a complete and meritorious response to the Appellants' reply brief including a rebuttal to each argument presented therein. Finally, it is appropriate to stress that, if the Examiner's response to this remand involves a new ground of

rejection, this rejection must be made in the forum of reopened prosecution (again see MPEP § 1208.01).

This application, by virtue of its "special" status, requires an immediate action; see MPEP § 708.01(D)(Rev. 1, Feb. 2003). It is important that the Board be promptly informed of any action affecting the appeal in this case.

REMAND

BRADLEY R. GARRIS)
Administrative Patent Judge)
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THOMAS A. WALTZ) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
) INTERFERENCES
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BEVERLY A. PAWLIKOWSKI)
Administrative Patent Judge)

BRG/jrg

FAY, SARPE, FAGAN, MINNICH & MCKEE, LLP
1100 SUPERIOR AVENUE, SEVENT FLOOR
CLEVELAND, OH 44114-2518